



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,876	09/29/2003	Shazia Sadiq	13909-115001 / 2003P00187	7312
32864 7590 01/09/2009 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SAINDON, WILLIAM V	
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			01/09/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### **DETAILED ACTION**

1. The following FINAL Office Action is in response to Applicant's submission received September 23, 2008. Claims 15, 18, 23, 31, 34, 38, 41, and 46 were amended. Claims 1-14 and 27-30 were canceled. No claims were added. Therefore, claims 15-26 and 31-48 are pending.

#### ***Response to Amendment***

2. Applicant's amendments are acknowledged.
3. The 35 USC § 101 rejection of claims 41-48 is withdrawn in light of Applicant's amendment directing the claims to proper Beauregard-style claims.
4. The 35 USC § 112 ¶ 2 rejection of claims 18 and 34 is withdrawn in light of Applicant's amendment eliminating the "progressively" term that was making the claims confusing.
5. The 35 USC § 102(b) rejection is withdrawn in light of Applicant's addition of the limitation: "simplification of a specification of the constraints."

#### ***Response to Arguments***

6. The 35 USC § 101 rejection of claims 15-26 and 31-40 is not withdrawn in light of Applicant's arguments.

**Claims 15-26:** Applicant argues that the addition of a "display" renders the claim a statutory system. However, the display is not the structure that the modeling tool and workflow engine operates on. Therefore, the claim remains drawn to software.

Art Unit: 3623

**Claims 31-40:** Applicant argues that the display is statutory subject matter that is manipulated in the claims. However, the display does not "tie" the claims to any statutory class. Extra-solution activities are not sufficient to tie claims to a machine. A display is clearly an extra-solution activity because displaying occurs after all the important parts of the claim have been performed. Therefore, the claim remains untied to a machine.

The 35 USC § 112 ¶ 2 rejection of claims 15 is not withdrawn in light of Applicant's argument. The claim remains unclear as to what hardware the software portion of the claim operates on. Software does not operate on a display, therefore the display does not cure the deficiencies of the claim.

7. The 35 USC § 112 ¶ 2 rejection of claims 16, 17, 19-21, 32, 33, 35-37, and 42-45 is withdrawn in light of Applicant's arguments. The Examiner is persuaded by Applicant's arguments and the rejection is withdrawn.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 15-26 and 31-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for simplification by redundancy or transitivity, does not reasonably provide enablement for all other methods of simplification. The specification does not enable any person skilled in the art to which it

Art Unit: 3623

pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claim attempts to cover all possible forms of simplification of constraints, but does not provide enabling support in the specification for any type of simplification other than those two mentioned in claim 23. Because other potential (and more complex) forms of simplification exist (but are not enabled by the specification), the specification is not enabling for this broad claim. For example, cyclical constraints occur, but Applicant does not address how to make and/or use the invention to simplify the constraint specification with cyclical tasks. The Examiner suggests that claim 23 be rolled into claim 15 (and their counterparts) in order to overcome this rejection.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3623

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 15-26 and 31-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shazia Sadiq et al., "Pockets of Flexibility in Workflow Specification," Proceedings of the 20th International Conference on Conceptual Modeling, Lecture Notes in Computer Science, 2224, pp. 513-526 (H.S. Kunii, et al., eds. 2001) in view of Official Notice.

Sadiq discloses all of the limitations as pointed out in the previous Office action mailed July 3, 2008 (not contested by Applicant), but fails to explicitly disclose:

simplify a specification of the constraints; and

a display operable to display tasks to a user.

However, the Examiner takes Official Notice that it is old and well known to use displays to display information. For example, chalkboards and computer monitors are often used to display results or list tasks. Further, the Examiner takes Official Notice that it is old and well known to simplify a specification of the constraints. For example, redundant constraints are removed from workflows to reduce unnecessary processing demands. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify the workflow system of Sadiq with the capability to simplify a specification of the constraints and to display the tasks of the user, for the purposes of quickly providing a result to a user.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jonathan Lee, "A High-Level Petri Nets-Based Approach to Verifying Task Structures," IEEE Transactions on Knowledge and Data Engineering, Vol. 14, No. 2 (March/April 2002), discloses various consistency and completeness issues that need to be simplified, including redundancy.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623